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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 09/771,226 | 01/26/2001 | William Franklin Harris | B-0103.28 | 6933 |

7590 02/06/2003

LAW OFFICES OF CHRISTOPHER L. MAKAY
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EXAMINER

TUCKER, PHILIP C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1712 | 6 |

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | | |
|-----------------|-----------|----------------|--------|
| Application No. | 771226 | Applicant(s) | HARRIS |
| Examiner | P. TUCKER | Group Art Unit | 1712 |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 11/20/02
 This action is FINAL.
 Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

Claim(s) 1 - 98 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
 Claim(s) 49 - 75, 96 - 98 is/are allowed.
 Claim(s) 1, 2, 4 - 12, 14 - 40, 42 - 48, 76, 77, 79 - 87, 89 - 95 is/are rejected.
 Claim(s) 3, 13, 41, 78, 88 is/are objected to.
 Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
 The proposed drawing correction, filed on _____ is approved disapproved.
 The drawing(s) filed on _____ is/are objected to by the Examiner.
 The specification is objected to by the Examiner.
 The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 All Some* None of the CERTIFIED copies of the priority documents have been received.
 received in Application No. (Series Code/Serial Number) _____.
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413
 Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152
 Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 27-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 27, the total weight percent of the composition is above 100%, when (a) is 75%.

In claim 33, the total weight percent is greater than 100%, when (a) is 50%. The dependent claims fall herewith.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619

(CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, 4-12, 14-40, 42-48, 76, 77, 79-87 and 89-95 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 16, 20, 27-30, 43, 47, 54, 55, 57-59, 72 and 76 of copending Application No. 09/905358. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims of 09/905358 differ by teaching the inclusion of solid particles, the suspension may comprise the same polymer (guar, cellulose, etc.), polyalkylene glycol and hydrogenated castor oil or wax as the present claims, and would the present claims obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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5. Claims 3, 13, 41, 78, 88 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 49-75 and 96-98 are allowable over the art of record.

7. Applicants amendments have overcome the prior rejections. New rejections are presented in this office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2731
February 5, 2003



PHILIP C. TUCKER
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